



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/447,052 | 11/23/1999 | SEISHI SUEHIRA | 1075.1124/JD | 3304 |

21171 7590 02/20/2003

STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

EXAMINER

BIENEMAN, CHARLES A

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

| | | | | |
|------------------------------|----------------------|--|---------------------|--|
| Office Action Summary | Application N | | Applicant(s) | |
| | 09/447,052 | | SUEHIRA, SEISHI | |
| | Examiner | | Art Unit | |
| | Charles A. Bieneman | | 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the following communications: original application, priority document, and Information Disclosure Statement, all filed on November 23, 1999.
2. Claims 1-48 are pending. Claims 1 and 48 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

5. **Claims 4-12** are objected to because of the following informalities: the phrase "file names same as" is not grammatical. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 1-48** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites converting non-structured documents into structured documents in lines 19-21. The specification discloses at various points that a CPU carries out this conversion

Art Unit: 2176

(e.g., page 19, lines 15-17; page 24, lines 25-27), but does not disclose the method or means by which the conversion is actually done. Therefore, the disclosure would not have enabled one skilled in the art to practiced the claimed invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,377,956 B1 to Hsu et al., issued April 23, 2002, filed February 22, 1999 in view World Wide Web Consortium, *XML Schema Part I: Structures*, W3C Working Draft (May 6, 1999). With respect to the rejection of each dependent claim below, the preceding rejection(s) of the relevant base claim(s) is incorporated therein.

Regarding **independent claim 1**, Hsu et al. teach setting in advance an original document storage area for storing the non-structured documents inasmuch as they teach specifying database tables or external files for the storage of component documents. (Hsu et al., col. 7, lines 26-32.) Hsu et al. also teach setting in advance a structured document storage area for storing structured documents obtained by conversion of the non-structured documents. (Hsu et al., col. 8, lines 16-18: "In the media preparation process, all source documents are processed and converted into standard formats, in particular, SGML, and are stored in the document database.")

Further, Hsu et al. do not explicitly teach but it would have been obvious to one of ordinary skill in the art to store the non-structured document into the original storage area each

Art Unit: 2176

time it was prepared or edited because it would have been obvious to one of ordinary skill that it would be desirable to have the most updated version of the non-structured document available for conversion to a structured document. (Hsu et al., col. 8, lines 16-18, quoted above.)

Further, Hsu et al. teach converting non-structured documents into structured documents and storing them in the structured document storage area. (Hsu et al., col. 8, lines 16-18.)

Further, Hsu et al. do not teach acquiring document names of the structured documents and preparing entity declarations for referring to entities of the structured documents. However, *XML Schema Part I* teaches in section 3.6.2 on page 38 external parsed entities, “a feature of XML that offers a method for including well-formed XML document fragments, including text and markup, by direct reference to the storage object of the parsed entity.” Further, in the example at the top of page 39, *XML Schema Part I* depicts entity declarations containing the names of structured documents. One of ordinary skill in the art would have recognized that these entity declarations provide a straightforward and efficient way to refer to component documents, and therefore, it would have been obvious to one of ordinary skill in the art to extend Hsu et al. to acquire document names of the structured documents and prepare entity declarations for referring to entities of the structured documents.

Further, Hsu et al. do not teach preparing the hub document based on the entity declarations regarding the structured documents. However, *XML Schema Part I* in the example in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the structured documents. Moreover, one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and

Art Unit: 2176

ensuring that the most up-to-date versions of components were used. Therefore, it would have been obvious to one of ordinary skill in the art to have prepared the hub document based on the entity declarations regarding the structured documents.

Regarding **dependent claim 2**, Hsu et al. teach an attachment file storage area set in advance, and storing attachment files into the storage area, inasmuch as they teach the original file storage area as discussed above regarding claim 1 and further state that “[m]edia files, which are also document objects, are also managed in the same way as component documents.” (Hsu et al., col. 7, lines 25-26.) Further, Hsu et al. do not teach preparing entity declarations for the attachment file or preparing the hub document based on the entity declarations for the attachment files as well as the entity declarations for the structured documents, but these elements would have been obvious to one of ordinary skill in the art in view of *XML Schema Part I* under the same rationale stated above regarding claim 1 for the obviousness of creating entity declarations and preparing the hub document based on the entity declarations regarding the structured documents.

Regarding **dependent claim 3**, the rejection of claim 2 above is fully incorporated herein. Further, Hsu et al. do not teach setting in advance an entity declaration storage area. However, in view of the obviousness of using entity declarations, discussed above regarding claim 1, it further would have been obvious to one of ordinary skill in the art to have set in advance an entity storage area because one of ordinary skill would have recognized the benefit of having a central storage area from which entity declarations could be accessed and used for multiple documents.

Art Unit: 2176

Regarding **dependent claims 4-6**, Hsu et al. do not teach the entity declarations of the structured documents having the same file names as the file names of the original unstructured document. However, one of ordinary skill in the art would have recognized that giving entity declarations the same names as the original unstructured document would have had the benefit of making clear to what original document the entity declaration referred, and therefore the step recited in these claims would have been obvious to one of ordinary skill in the art.

Regarding **dependent claims 7-12**, Hsu et al. do not teach the entity declarations for the attachment files having the same file names as the file names of the non-structured documents to which the attachment files are attached. However, one of ordinary skill in the art would have recognized that giving attachment entity declarations the same names as the original unstructured document would have had the benefit of making clear to what original document the attachment was attached, and therefore the step recited in these claims would have been obvious to one of ordinary skill in the art.

Regarding **dependent claims 13-24**, Hsu et al. teach the attachment files being graphic files including graphic information. (Hsu et al., col. 7, lines 61-65: "For each component document, the author also prepares for all needed multimedia files for diagrams, images, drawings, etc. in some standard formats such as CGM, TIFF, GIF, etc., which may be incorporated in the SGML files.")

Regarding **dependent claims 24-48**, Hsu et al. teach that the structured documents a Standard Generalized Markup Language (SGML) documents whose structure is defined by a Document Type Definition (DTD). (Hsu et al., col. 7, lines 33-37: "Component documents are preferably represented in SGML (See SGML: Standard Generalized Markup Language, ISO/IEC

Art Unit: 2176

8879:1986). SGML is a meta-language for defining document structures, referred to as Document Type Definition (DTD). An SGML document structure is an instance of its associated DTD.”)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| U.S. Patent Number | Name | Issue Date | File Date | |
|--------------------|----------------|------------|-----------|--|
| 6,507,858 B1 | Kanerva et al. | 1/14/03 | 2/25/98 | |
| 6,490,603 B1 | Keenan et al. | 12/3/02 | 3/19/99 | |
| 6,202,072 B1 | Kuwahara | 3/13/01 | 12/5/97 | |
| 6,101,511 | DeRose et al. | 8/8/00 | 7/19/91 | |
| 6,014,680 | Sato et al. | 1/11/00 | 8/29/96 | |
| 5,655,130 | Dodge et al. | 8/5/97 | 10/14/94 | |

11. World Wide Web Consortium, *Document Definition Markup Language (DDML) Specification, Version 1.0*, W3C Note (January 19, 1999). See especially section 2.6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Application/Control Number: 09/447,052


Page 8

Art Unit: 2176

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

CAB

January 27, 2003


HEATHER H. ...
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100